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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,575	12/20/2000	Robert M. Judd	39385.01P1	8449

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NEAL, GERBER, & EISENBERG
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CHICAGO, IL 60602

EXAMINER

VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 02/20/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,575

Applicant(s)

JUDD ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-70 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the applicant's communication filed on 12/20/2000.
2. Claims 1-70 are pending and presented for examination.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, 62, 63; 22-23; 24-27; 30-36; 51-52 and 59-62, drawn to a method of managing medical images by converting the images to a common images format suitable for display on a computer screen wherein a user can view them, classified in class 707, subclass 101.
 - II. Claims 13-17 and 28-29, drawn to an image database of generating an image using different format in response to a user request and display the image at the user or the client computer, classified in class 707, subclass 102.
 - III. Claims 18-21 and 37-40, drawn to an image database comprising images organized in a hierarchical data structure, classified in class 707, subclass 104.1.
 - IV. Claims 41-50, 64, 65 and 53-55, drawn to a method of managing medical images by determining a region of diagnostic interest and adjusting image quality of the medical image, classified in class 382, subclass 128.
 - V. Claims 56-58 and 66-70, drawn to a method of accessing a database comprising medical images using an internet address data format wherein the images are stored in a browser compatible format and retrieving from the database a plurality of medical images, classified in class 707, subclass 3.
4. The inventions are distinct, each from the other because of the following reasons:

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Inventions I, II, III, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as it is usable in a method of managing medical images by converting the images to a common images format suitable for display on a computer screen wherein a user can view them, classified in class 707, subclass 101. Without requiring an image database of generating an image using different format in response to a user request and display at user or client computer of group II, classified in class 707, subclass 102. Without requiring an image database comprising images organized in a hierarchical data structure of group III, classified in class 707, subclass 104.1. Without requiring a method of managing medical images by determining a region of diagnostic interest and adjusting image quality of the medical image of group IV, classified in class 382, subclass 128. Without requiring a method of accessing a database comprising medical images using an internet address data format wherein the images are stored in a browser compatible format and retrieving from the database a plurality of medical images of group V, classified in class 707, subclass 3. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and because the search required for each group is different and not co-extensive for examination purpose, these groups would require different searches in PTO's classification class and subclass. The group I search (1-12,62,63; 22-23; 24-27; 30-36; 51-52 and 59-62) would require use of search classified in Class 707, subclass 101, which would not required for Groups II, III, IV and V. The group II search (13-17 and 28-29) would require use of search classified in Class 707, subclass 102, which would not required for Groups I, III, IV and V. The group III search (18-21 and 37-40)

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would require use of search classified in class 707, subclass 104.1, which would not required for groups I, II, IV and V. The group IV search (41-50, 64, 65 and 53-55) would require use of search classified in class 382, subclass 128, which would not required for groups I, II, III and V. The group V search (56-58 and 66-70) would require use of search classified in class 707, subclass 3, which would not required for groups I, II, III and IV. Therefore restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of the of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. **Any response to this action should mailed to :**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 305-9051 (for formal of draft communication intended for entry)

Or:

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(703) 308-5357 (for informal of draft communications, please label

“PROPOSED” or “DRAFT”)

Hand- delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington VA, Sixth floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (703) 305-7094. The examiner can normally be reached on Monday-Friday from 8:30 AM to about 4:00 PM., and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830. The fax phone number for this group is (703) 308-5403.

J.V.

Jacques Veillard
Patent Examiner TC 2100

February 10, 2004

Charles Rones
CHARLES RONES
PRIMARY EXAMINER